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09/990,605	11/20/2001	Scott Montgomery	703602.6	3869

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EXAMINER
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OBEID, MAMON A

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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11/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/990,605	<b>Applicant(s)</b> MONTGOMERY ET AL.	
	<b>Examiner</b> MAMON OBEID	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 180-215 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 180-215 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2009 has been entered.

### ***Acknowledgements***

2. This communication is in reply to the RCE noted above.
3. Claims 1-179 have been canceled.
4. Claims 180-215 have been added.
5. Claims 180-215 are pending and have been examined.

### ***Restrictions***

6. Restriction to one of the following inventions is required under 35 U.S.C 121:
  - I. Claims 180-197, drawn to a method, classified in class 382, subclass 101.
  - II. Claims 198-215, drawn to a system, classified in class 705, subclass 62.
7. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

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practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the Instant case, Group II is currently not patentably distinct from Group I (e.g. they are obvious over each other). Therefore, a restriction is improper at this time. However, if Applicants amend any claims such that Group II becomes patentably distinct from Group I, this restriction may be implemented.

### ***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required: "indexing tracking identifier" in at least claim 180.

### ***Claim Rejections - 35 USC § 112-2<sup>nd</sup>***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 180- 215 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 180, recites: "reading, at the United States Postal Service, a one-dimensional bar code representative of an indexing tracking identifier, the one-

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dimensional bar code being located on a mail piece handled by the United States Postal Service, and wherein a postage indicium comprising a two- dimensional bar code is further located on the mail piece;" One of ordinary skill in the art would interpret this limitation such that the United States Postal Service is already in possession of the postage indicium. Claim 180 continues to recite: "transmitting a postage indicium request from the United States Postal Service to a vendor-controlled postage-issuing computer system, wherein the postage indicium request includes the indexing tracking identifier that the one-dimensional bar code represents;" One of ordinary skill in the art would interpret this limitation such that the United States Postal Service is not in possession of the postage indicium. Based on the conflicting evidence noted above, One of ordinary skill in the art would not be able to ascertain whether the United States Postal Service is in possession of the postage indicium or not. Therefore the claims are indefinite. Appropriate correction is required.

12. Claim 180, for example, recites: "reading, at the United States Postal Service, a one-dimensional bar code representative of an indexing tracking identifier". One of ordinary skill in the art would interpret this limitation such that the one-dimensional bar code includes indexing tracking identifier. Therefore, the one-dimensional bar code can not be representing any other information. Claim 192, for example, recites: "wherein the two-dimensional bar code is readable to provide a meter number that is not part of the indexing tracking identifier." One of ordinary skill in the art would interpret this limitation such that the one-dimensional bar code does represent other information such as the

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meter data. Based on the conflicting evidence noted above, one of ordinary skill the art would not be able to ascertain whether the one-dimensional bar code represents the indexing tracking identifier only or whether it represents other information (e.g. meter number) as well. Therefore, the claims are indefinite. Appropriate correction is required. The same argument applies for claims 193, 210 and 211.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 180-182, 184,190, 192-200, 202-208 and 210- 215 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of Sansone (U.S. Patent No. 6,547,136 B1) ("Sansone").

15. **As per claims 180-181 and 198-199:** Gordon discloses:

a. reading, at the United States Postal Service (e.g. "postal authority 10"), a one-dimensional bar code representative of an indexing tracking identifier (e.g. serial number, transaction number, or address), the one-dimensional bar code being Located on a mail piece (e.g. mailpiece) handled by the United States

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Postal Service, and wherein a postage indicium (e.g. postage indicia) comprising a two- dimensional bar code is further located on the mail piece (column 3, lines 13-26; figures 6 & 7 and related text);

b. transmitting a postage indicium request from the United States Postal Service to a vendor-controlled postage-issuing computer system ("server 22"), wherein the postage indicium request includes the indexing tracking identifier that the one-dimensional bar code represents (column 5, lines 21- 33; column 6, lines 1- 6; column 6, line 66-column 7, line 28); and

c. receiving, at the United States Postal Service, data corresponding to the requested postage indicium from the vendor-controlled postage-issuing computer system, wherein the United States Postal Service submits the mail piece for delivery in response to the data corresponding to the requested postage indicium indicating that the postage indicium located on the mail piece is valid (column 6, line 66-column 7, line 28; column 8, lines 3-14; figures 4, 5 and related text).

16. Gordon further discloses a mailer's computer **12** transmits a request for postage indicia including payment information (e.g. payment request) to the postal authority **10**. Once the request for postage has been fully processed within the postal authority, the cryptographically secured or plain text postage indicia is transmitted to the mailer (column 4, lines 30-65). Gordon further discloses encoding postage information in machine readable form (e.g. bar code).

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17. Gordon does not specifically disclose a one-dimensional bar code and a two-dimensional bar code. However, Sansone clearly discloses a one-dimensional barcode (e.g. Bar code 253 or delivery confirmation code 254) and a two-dimensional barcode (e.g. bar code 98 or indicia 90).

18. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a one-dimensional and a two-dimensional barcodes, as disclosed by Sansone to comply with the USPS IBIP Requirements of incorporating both a one-dimensional and two-dimensional barcodes thereby increasing system performance and preventing postage fraud ("Postal Service -Information Based Indicia Program (IBIP) - Performance Criteria for Information-Based Indicia and Security Architecture for Open IBI Postage Evidencing Systems (BCIBI-O)", USPS, June 25, 1999, pages A1 and C10) ("USPS IBIP Requirements").

19. Claims 180-182, 184,190, 192-200, 202-208 and 210- 215 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of Applicants-admitted prior art ("APA").

20. **As per claims 180-181 and 198-199:** Gordon discloses:

d. reading, at the United States Postal Service (e.g. "postal authority 10"), a one-dimensional bar code representative of an indexing tracking identifier (e.g.



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serial or transaction number, or address), the one-dimensional bar code being Located on a mail piece (e.g. mailpiece) handled by the United States Postal Service, and wherein a postage indicium (e.g. postage indicia) comprising a two-dimensional bar code is further located on the mail piece (column 3, lines 13-26; figures 6 & 7 and related text);

- e. transmitting a postage indicium request from the United States Postal Service to a vendor-controlled postage-issuing computer system ("server 22"), wherein the postage indicium request includes the indexing tracking identifier that the one-dimensional bar code represents (column 5, lines 21- 33; column 6, lines 1- 6; column 6, line 66-column 7, line 28); and
- f. receiving, at the United States Postal Service, data corresponding to the requested postage indicium from the vendor-controlled postage-issuing computer system, wherein the United States Postal Service submits the mail piece for delivery in response to the data corresponding to the requested postage indicium indicating that the postage indicium located on the mail piece is valid (column 6, line 66-column 7, line 28; column 8, lines 3-14; figures 4, 5 and related text).

21. Gordon further discloses a mailer's computer **12** transmits a request for postage indicia including payment information (e.g. payment request) to the postal authority **10**. Once the request for postage has been fully processed within the postal authority, the cryptographically secured or plain text postage indicia is transmitted to the mailer

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(column 4, lines 30-65). Gordon further discloses encoding postage information in machine readable form (e.g. bar code).

22. Gordon does not specifically disclose a one-dimensional bar code and a two-dimensional bar code. However, APA clearly discloses that a use of a one-dimensional barcode comprising a tracking ID, a delivery confirmation code and a two-dimensional barcode are old and well known in the art (application publication: at least ¶ [0088]).

23. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a one-dimensional and a two-dimensional barcodes, as disclosed by APA, to comply with the USPS IBIP Requirements of incorporating both a one-dimensional and two-dimensional barcodes thereby increasing system performance and preventing postage fraud (see USPS IBIP Requirements, pages A1 and C10).

24. **As per claims 182 and 200:** Gordon further discloses wherein the data corresponding to the requested postage indicium represents one or more of a postage amount, a date and time of postage information creation, a service class, an optional data advance, or a delivery zip code (column 1, lines 53- 66; column 9, lines 51- 65).

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25. **As per claims 183 and 201:** Gordon further discloses wherein the mail piece further comprises the indexing tracking identifier in a human-readable format (column 1, lines 53- 66; column 10, lines 8- 15).

26. **As per claims 184 and 202:** Gordon further discloses wherein the United States Postal Service reads the two-dimensional bar code located on the mail piece subsequent to transmitting the postage indicium request to the vendor-controlled postage-issuing computer system (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

27. **As per claims 186 and 204:** Gordon further discloses wherein the United States Postal Service sends the generated indexing tracking identifier to the vendor-controlled postage-issuing computer system (column 6, lines 1- 6).

28. **As per claims 187 and 205:** Gordon further discloses wherein the two-dimensional bar code is readable to provide the data corresponding to the requested postage indicium (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

29. **As per claims 188, 192-193 and 210-211:** Gordon discloses as shown above. Gordon does not disclose wherein the data corresponding to the requested postage indicium comprises the indexing tracking identifier and either a meter number or an

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account number. However, Sansone clearly discloses indicia 90 comprising a postal security device serial number (column 5, lines 16- 34).

30. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to include a device serial number in postage indicia, as disclosed by Sansone, to increase the postage indicia's security thereby reducing fraud.

31. **As per claims 189 and 207:** Gordon further discloses wherein the data corresponding to the requested postage indicium includes digitally signed data (column 5, lines 1-20).

32. **As per claims 190 and 208:** Gordon further discloses wherein the two-dimensional bar code is readable to provide the data corresponding to the requested postage indicium and the indexing tracking identifier (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

33. **As per claims 194 and 212:** Gordon further discloses wherein the United States Postal Service transmits the postage indicium to the vendor-controlled postage-issuing computer system and receives the data corresponding to the requested postage indicium from the vendor-controlled postage- issuing computer system over a network.

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34. **As per claims 195 and 213:** Gordon further discloses displaying the data corresponding to the requested postage indicium at the United States Postal Service (column 2, line 63- column 3, line 12; column 4, lines 30- 46).

35. **As per claims 196 and 214:** Gordon further discloses verifying proof of payment for the postage indicium located on the mail piece from the data displayed at the United States Postal Service (column 2, line 63- column 3, line 12).

36. **As per claims 197 and 215:** Gordon further discloses wherein the data displayed at the United States Postal Service comprises a sender address for the mail piece (column 2, line 63- column 3, line 12).

37. Claims 185, 191, 203 and 209 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of Sansone (U.S. Patent No. 6,547,136 B1) ("Sansone") and further in view of Woods et al (U.S. Patent Application Publication No. 20020152174 A1) ("Woods")

38. **As per claims 185, 191, 203 and 209:** Gordon/ Sansone discloses as shown above. Gordon/ Sansone does not explicitly disclose generating a serial number or transaction number at the postal authority 10 and sending the generated serial number or transaction number to server 22. However, Woods discloses the following:

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g. generating the indexing tracking identifier at the United States Postal Service in response to the United States Postal Service receiving an indexing tracking identifier request from the vendor-controlled postage-issuing computer system (§ [0054]-[0056]); and

h. sending the generated indexing tracking identifier from the United States Postal Service to the vendor-controlled postage-issuing computer system, wherein the United States Postal Service generates and sends the indexing tracking identifier prior to reading the one- dimensional bar code located on the mail piece (§ [0054]-[0056]).

39. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a tracking number to be sent to a postage provider, as disclosed by USPS IBIP Requirements, to comply with the USPS IBIP Requirements to enable a user or provider to track a package as its being delivered between the USPS facilities to provide a user-friendly system (USPS IBIP Requirements: pages A1 and C10; Woods: § [0054]).

40. Claims 185, 191, 203 and 209 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of APA and further in view of USPS IBIP Requirements.

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41. **As per claims 185, 191, 203 and 209:** Gordon/APA discloses as shown above.

The combination Gordon/APA does not expressly discloses generating a serial number or transaction number at the postal authority pr postal service and sending the generated serial number or transaction number to a server or vendor. However, USPS IBIP Requirements clearly disclose the following:

- i. generating the indexing tracking identifier at the United States Postal Service in response to the United States Postal Service receiving an indexing tracking identifier request from the vendor-controlled postage-issuing computer system (page C-10); and
- j. sending the generated indexing tracking identifier from the United States Postal Service to the vendor-controlled postage-issuing computer system, wherein the United States Postal Service generates and sends the indexing tracking identifier prior to reading the one- dimensional bar code located on the mail piece (page C-10).

42. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a tracking number to be sent to a postage provider, as disclosed by USPS IBIP Requirements, to comply with the USPS IBIP Requirements to enable a user or provider to track a package as its being delivered between the USPS facilities to provide a user-friendly system (USPS IBIP Requirements: pages A1 and C10).

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### ***Response to Arguments***

43. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the Examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

44. Applicants are reminded that recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited in the Notice of References Cited (form PTO-892).

46. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim



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amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

47. Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

48. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The Examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

49. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid  
Examiner  
Art Unit: 3621  
November 10, 2009

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685